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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Plan-A-Day Enterprises, Ltd.

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Serial No. 75/807,556

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Nathaniel D. Kramer of Cobrin & Gittes for Plan-A-Day Enterprises, Ltd.

Ronald McMorrow, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Wendel, Bucher and Drost, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Plan-A-Day Enterprises, Ltd. has filed an application to register the mark THE DAILY PLANNER and design, in the format shown below, for "mail order catalog services featuring stationery and related gift items, especially desk accessories, globes, atlases, travel clocks and timepieces; computerized on-line retail services featuring stationery and related gift items, especially desk

accessories, globes, atlases, travel clocks and timepieces."<sup>1</sup>



Registration has been finally refused on the basis of applicant's failure to comply with the requirement that a disclaimer be filed of the words THE DAILY PLANNER apart from the mark as shown. Section 6(a) of the Trademark Act; TMEP Sections 1213 and 1213.02(a). Although applicant amended the application to one seeking registration under the provisions of Section 2(f) with respect to the words THE DAILY PLANNER, the claim of acquired distinctiveness was deemed insufficient to overcome the requirement on the basis that the wording is generic and must be disclaimed. TMEP Section 1213.02(b).

Applicant and the Examining Attorney have filed briefs but an oral hearing was not requested.

The Examining Attorney maintains that since THE DAILY PLANNER is a common descriptive name for a central

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<sup>1</sup> Serial No. 75/807,556, filed September 24, 1999, claiming first use and first use in commerce of the mark in a different form in

characteristic of applicant's services, the words must be disclaimed as being generic when used in connection with applicant's services. In making this requirement, the Examining Attorney relies upon the principle set forth by the Board in *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1227 (TTAB 1987), with the citation of several other cases in support thereof, that "a term that is a common descriptive name for a central characteristic of a service is incapable of distinguishing the service from like services of others."

As evidence of the generic nature of the term "daily planner" when used to designate a particular type of stationery item, the Examining Attorney has made of record five registrations in which the "daily planner" is included as one of the items in the identification of goods, a sampling of advertisements taken from the Internet in which "daily planners" are included as specific goods being offered for sale, and numerous excerpts retrieved from the Nexis database using the term "daily planner" in a generic manner. As representative of the latter, we note the following:

Thomas Nelson Gifts introduced updated daily planners

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1990 and first use and first use in commerce of the mark in the current form in April 1999.

in eight different styles. *Gifts & Decorative Accessories* (December 1, 1999);

... and their fellow students each received a daily planner as a gift. It looks like a spiral notebook, but it has many added features, such as a calendar for writing... *Newsday* (September 25, 1995);

An organizer notebook or daily planner. *News & Record (Greensboro, NC)* (April 24, 1995);

Calendars and Daily Planners: Silver Creek Press consistently prints some of the prettiest calendars and daily planners for sportsmen. *The Dallas Morning News* (December 5, 1993); and

My first step was to call all of the major department and stationery stores to ask if they carried a daily planner targeted for kids. *Portland Skanner* (October 6, 1993).

As evidence that applicant deals in goods of this nature, the Examining Attorney points to applicant's specimens which show various types of "organizers" as featured items for sale in connection with its mail order or on-line retail services. The Examining Attorney concludes that the sale of daily planners is a central feature of applicant's recited services and thus applicant's mark cannot be registered without a disclaimer of the generic wording THE DAILY PLANNER.

Applicant contends that the Examining Attorney has failed to offer any evidence that THE DAILY PLANNER is generic for applicant's services. Instead, applicant argues, all of the evidence is directed to the question of

whether the term "daily planner" is generic for a type of goods, namely, organizers. Applicant insists that although a term may be generic for a type of goods sold by a retailer, it cannot simply be concluded, without further evidence, that the term is also generic for retail sale services featuring those goods. Applicant argues, there is no showing that "daily planner" is a commonly used generic term for a store featuring the sale of organizers.

Applicant claims that *Bonni Keller* case relied upon by the Examining Attorney does not support the broad application of the principle that a term which is generic for a type of goods is also generic for retail store services featuring those goods. Applicant notes that in the *Bonni Keller* case the mark was LA LINGERIE and there was evidence of record that retail stores selling lingerie were called "lingerie" shops or stores. 6 USPQ2d at 1226. Here, applicant notes, there is no evidence that "daily planner" is a commonly used term for a type of store and thus the *Bonni Keller* case is not applicable.

Applicant further argues that the controlling decision in this case is *In re Seats*, 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985) in which, according to applicant, the Court found a showing of genericness of the term SEATS in relation to chairs or bleachers insufficient to show that

it was also generic for the service of selling seats at various events. Applicant insists the same is true here; that whether or not DAILY PLANNER may be generic for particular goods, there is no showing or evidence that it is equally generic for the recited retail services.

Finally, applicant points to several third-party registrations in which the Office has registered a mark for services, without any disclaimer, despite the fact that the mark is generic for a type of goods typically sold by the retailer. These registrations include marks such as LETTUCE, THE RIPE TOMATO, and BLUE ONION for restaurant services, THE BUCKLE for clothing store services, and STAPLES for office supply store services.

As a general principle a term which is a generic name for a central characteristic of a service is incapable of distinguishing the services from like services of others. See *In re Bonni Keller Collections Ltd.*, *supra* (LA LINGERIE held incapable of distinguishing applicant's retail store services in the field of lingerie); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE held incapable of functioning as a service mark to identify applicant's mail order and distributorship services in the field of wicker furniture and accessories); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219 (TTAB 1984) (HALF

PRICE BOOKS RECORDS MAGAZINES held incapable of designating origin).

From the evidence of record, we find that the term "daily planner" is a generic name for a type of stationery item. There is no real controversy on the applicability of the term to a type of goods. Nor does there appear to be any argument on applicant's part that the term "daily planner" is not used interchangeably with "organizer." Furthermore, from the specimens of record we find that applicant touts as a special feature of its mail order and on-line retail services its full line of personal organizers from the FILOFAX line, ranging from mini or pocket organizers to desk diaries. While pointing out that applicant also carries a wide selection of other items, such as pens, desk accessories and leather bags, the emphasis in the catalog as well as in the photographs on the cover is obviously on organizers, otherwise known as "daily planners."

As such, we find the evidence sufficient to demonstrate that the sale of daily planners is a basic feature of applicant's mail order and on-line retail services. Or to put it in the words previously used by the Board, the term DAILY PLANNER, as used by applicant in connection with its services, is a generic name for a

central characteristic of applicant's retail services.

Applicant sells daily planners as its main product; its retail services focus on the sale of daily planners.

While applicant argues that there is no evidence that "daily planner" is a commonly used term for a store featuring the sale of organizers, we do not find specific evidence of the prior use of the term in a generic manner for stores of this type necessary. It is true that in the *Bonni Keller* case, there was actual evidence of the use of the term "lingerie" in connection with the stores selling these goods, as well as the goods per se. But the same did not hold true in the *Wickerware* case. There the evidence was of use of the term "wickerware" generically with respect to products made of wicker; from this evidence the Board concluded that "the term 'wickerware' is as incapable of distinguishing the services of selling wicker as it is for the products themselves." 227 USPQ at 971. The Board went on to state:

That the evidence which the Examining Attorney introduced does not specifically demonstrate use in connection with services does not dissuade us from our conclusion as it is obvious that the only conceivable significance of the term in relation to the service of retail selling is to inform prospective customers that the services involve the sale of wickerware.

Id. at 971.



The critical issue in determining genericness of a term under any circumstances is whether members of the relevant public would primarily use or understand the designation sought to be registered to refer to the genus or category of goods or services in question. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). In making this determination in this case, we must follow the two-step inquiry set forth in *Marvin Ginn* and reaffirmed by the Court in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), namely;

- (1) What is the genus or category of services at issue?, and
- (2) Is the designation sought to be registered understood by the relevant public primarily to refer to that genus or category of services.

Here the category of services is mail order or on-line retail sale services featuring as the main products various types of daily planners. Thus, we can only conclude that THE DAILY PLANNER, when used in connection with sales of this nature, would be understood by the relevant purchasing public as referring to retail services in which products of this type were the featured items.

Although applicant attempts to draw an analogy here to *In re Seats, Inc.*, *supra*, the Court clearly drew a distinction between the generic use of the term "seats" for chairs or couches or bleachers and the non-generic use of the term in connection with reservation services, as opposed to the selling of seats per se, "as would for example a furniture merchant." 225 USPQ at 368. No such distinction can be made here; applicant is selling the very product that the term THE DAILY PLANNER names.

Finally, we can give little weight to the third-party registrations which applicant has submitted in which, although a certain type of product sold by the retailer is named in the mark, no disclaimer was required. It is readily apparent that items such as "lettuce," when used in connection with restaurant services, or "buckles," when used in connection with clothing store services, do not name a central characteristic or basic feature of the services involved. By comparison, the Examining Attorney has introduced several third-party registrations in which the item named in the mark is a basic feature of the retail services involved, such as "shoes" or "clothing," and in these instances, disclaimers have been required.

Accordingly, we find the wording THE DAILY PLANNER as used in applicant's composite mark to be generic, when used

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in connection with applicant's recited services, and thus the requirement for a disclaimer thereof is proper.

Pursuant to Trademark Rule 2.142(g), this decision will be set aside and applicant's mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, submits a disclaimer of THE DAILY PLANNER apart from the mark as a whole.

Decision: The requirement for a disclaimer is affirmed.